

REMARKS

The Official Action of August 20, 2008, and the prior art relied upon therein have been carefully studied. The claims in the application are now claims 1-16, including new claims 15 and 16 which fall within the elected subject matter, and withdrawn claims 9-12. Applicants believe and respectfully submit that the claims define a patentable subject matter and should be allowed, whereby favorable reconsideration and allowance are earnestly solicited.

Acknowledgement by the PTO of the receipt of applicants' papers filed under Section 119 is noted.

The restriction requirement has been repeated and made final, whereby claims 9-12 have been withdrawn from further consideration.

Applicants respectfully request reconsideration. Claims 1 and 9 share the same common and patentable subject matter as will be pointed out below, and therefore unity of invention exist. Rejoining, examination on the merits, and allowance of claims 9-12 along with the other claims are respectfully requested.

The examiner has noted that there is a typographical error in paragraph [0015]. Applicants have been unable to find a typographical error.

Nevertheless, some amendments have been made to the specification to improve idiomatic English and to place the specification in better form according to U.S. practice.

Claim 1 has been amended to specify that there is not any meaningful presence of any mineral filler other than the ultrafine chalk, and that such ultrafine chalk is "uncoated", support for the latter amendment being found at page 8, lines 2-4 of the specification.

New claims 15 and 16 have been added, claim 15 being similar to claim 1, but without the "uncoated" recitation and based on the particle size as recited in claim 13. Claims 15 and 16 are patentable for reason which will be apparent from the remarks presented below.

Claims 1-6, 13 and 14 have been rejected under Section 103 as obvious from Kumaki et al EP 0863180 (Kumaki). This rejection is respectfully traversed.

Kumaki discloses a polyamide resin composition containing, as stated in the abstract and elsewhere, both a non-fibrous inorganic filler and a fibrous inorganic filler.

On the other hand, the examples appear to disclose polyamide compositions which contain only one filler, usually Kaolin, but wherein the Kaolin is of a very large particle size compared with ultrafine chalk used in the present invention, i.e. the Kaolin used in the examples of Kumaki is of an average particle diameter of 800 nm, almost a whole order of magnitude greater than the maximum size permitted according to the present invention, more precisely eight times (8X) larger.

It is true that the range of particle size broadly disclosed by Kumaki overlaps the required particle size utilized in the present invention. Nevertheless, Kumaki teaches away from the present invention including the particle size because (1) the broader range is clearly not favored, and what the person of ordinary skill in the art would learn from Kumaki is that a particle size greater than 100 nm should be used, and certainly a particle size considerably greater than 80 nm or 70 nm should be used; and (2) by following the broad teachings of Kumaki as opposed to the examples wherein a comparatively very large particle size of Kaolin is used, the skilled artisan should use a second filler, namely a fibrous inorganic filler, the presence of any significant quantity of which is prohibited according to the present invention.

In addition and particularly in conjunction with claims 1 and (withdrawn) 9, and the claims which depend

therefrom, the ultrafine chalk used in the present invention is "uncoated". In Kumaki, to the contrary, it appears that the non-fibrous inorganic filler is always coated or is admixed with an agent which provides a coating. Thus, the treatment of the surface of the non-fibrous inorganic filler with a coupling agent is disclosed as being preferred (Kumaki page 4, lines 2-5). As an alternative to such surface pre-treatment, the coupling agent is added when the filler and the polyamide resin are melted and kneaded together (Kumaki page 4, lines 20-22).¹ In each case, the coupling agent results in a surface treatment of the non-fibrous inorganic filler.

As an alternative to surface treatment with a coupling agent, Kumaki discloses pretreatment of the filler with an olefin compound (see Kumaki at page 5, lines 1-34).

Returning to the examples of Kumaki in which the particle size of the Kaolin is 800 nm, it should be noted that the Kaolin particles were pretreated with an aminosilane (see footnote 3 of Table 1).

When a prior patent or publication contains a very broad and general disclosure, i.e. a "basket" or "shotgun" disclosure, one must take into account what the patent or

¹ It is of interest that during the examination proceedings at the EPO, Kumaki was urged to insert this coupling agent as element (c) into Kumaki's claim 1, from which the person skilled in the art learns from the granted Kumaki patent (EP0 863 180) that such a surface treatment of Kumaki's inorganic filler is essential.

publication actually teaches the person of ordinary skill in the art, bearing in mind that it is impossible for such person of ordinary skill in the art to try every possible option within such a broad shotgun or basket disclosure. The most compelling teachings are those of the examples, and the examples of Kumai teach a relatively large particle size and a surface treatment of such particles.²

The person of ordinary skill in the art, reading Kumaki would not be led to adopt applicants' process, as there is no apparent reason to deviate from what is preferred in Kumaki. Applicants' claims therefore define non-obvious subject matter.

Withdrawal of the rejection is in order and is respectfully requested.

Claim 7 has been rejected under Section 103 as obvious from Kumaki in view of either Yasue et al USP 5,414,042 (Yasue) or Umetsu et al USP 6,121,388 (Umetsu). This rejection is respectfully traversed.

The secondary references have not been applied to make up for the deficiencies of Kumaki alone as applied

² And if one goes to the broader disclosure, then the clear teaching of the broader disclosure is to include a second filler, namely a fibrous filler along with the non-fibrous filler.

against claim 1. As claim 7 depends from and incorporates the subject matter of claim 6 (including claim 1), it follows that the proposed combination, even if such combination were obvious, would not reach even claim 1, let alone claims 6 and 7.

Accordingly, withdrawal of the rejection is in order and is respectfully requested.

Claims 6-8 have been rejected under Section 103 as obvious from Tahara et al USP 6,165,407 (Tahara) in view of Kumaki. This rejection is respectfully traversed.

Even if it were obvious to utilize the teachings of Kumaki in modification of Tahara, claims 6-8 would not be reached because of the deficiencies pointed out above in Kumaki relative to the present invention as recited in claim 1 (incorporated into claims 6-9).

Withdrawal of the rejection is in order and is respectfully request.

The prior art documents of record and not relied upon by the PTO have been noted, along with the implication that such documents are deemed by the PTO to be insufficiently material to warrant their application against any of applicants' claims.

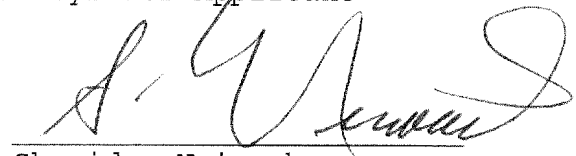
Appln. No. 10/526,767
Amendment dated November 20, 2008
Reply to Office Action dated August 20, 2008

Applicants believe that all issues raised in the Official Action have been addressed above in a manner that should lead to patentability of the present application. Favorable consideration and early formal allowance are respectfully requested.

Respectfully submitted,

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By

A handwritten signature in black ink, appearing to read 'S. Neimark', written over a horizontal line.

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